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Paper 1
Declared: 20 February 2009

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4 UNITED STATES PATENT AND TRADEMARK OFFICE
5 BOARD OF PATENT APPEALS AND INTERFERENCES
6

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8 Patent Interference 105,685 McK
9 Technology Center 1600
10

11
12 ANTHONY F. HADFIELD, SYED M. SHAH,
13 MICHAEL W. WINKELY, KAREN W. SUTHERLAND,
14 JAMES A. PROVOST, AERI PARK, REX A. SHIPPLETT,
15 BRENTON W. RUSSELL and BEAT T. WEBER
16

17 Patent 6,673,838 B2,
18 Junior Party,
19

20 v.
21

22 THOMAS P. JERUSSI, CHRISANTHA H. SENANAYAKE
23 and NANDKUMAR N. BHONGLE,
24

25 Application 10/720,134,
26 Senior Party.
27

28
29 Before: Fred E. McKelvey, *Senior Administrative Patent Judge.*
30

31 DECLARATION
32

Part A Declaration of Interference

4 An interference is declared pursuant to 35 U.S.C. § 135(a).

5 Details of the application, patent, count and claims designated
6 as corresponding or as not corresponding to the count appear in
7 Parts E and F.

Part B Designation to manage

12 Senior Administrative Patent Judge Fred E. McKelvey has been
13 designated to manage the interference. 37 CFR § 41.104(a).

Part C Standing Order

18 A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)
19 accompanies this DECLARATION.

20 The STANDING ORDER applies to this contested case.

Part D

Initial Conference Call and Motions Lists

Conference Call

25 A conference call to set dates for action in this contested case
26 is scheduled for:

27 2:00 p.m. (1400 hours Eastern Time) on 1 April 2009.

28 The Board will initiate the conference call.

Motions Lists

On or before:

Noon (1200 hours Eastern time) on 26 March 2009,

4 each party shall file, and on or before:

5:00 p.m. (1700 hours Eastern time) on 26 March 2009,

6 each party shall serve a notice stating the relief the party requests,

7 *i.e.*, a motions list including motions the party seeks authorization to

8 file. 37 CFR §§ 41.120(a) & 41.204; STANDING ORDER ¶ 104.2.1

9 120 & 204.

The default procedure for filing and serving motions lists is that motions lists are to be *filed* before being *served*.

By filing before service, one party will not have access to an opponent's motions list prior to the filing of the party's motions list.

Nevertheless, the parties may mutually agree to discuss and serve motions lists at any time prior to the date and time motions lists are due.

The following shall be included in motions lists.

(1) Proposed motion for benefit (*i.e.*, to be accorded an earlier constructive reduction to practice) must identify the application(s) for which benefit will be sought.

(2) Proposed motion to attack benefit must identify the application(s) to be attacked.

(3) Proposed motion seeking judgment against an opponent based on alleged unpatentability must identify the statutory basis for the alleged unpatentability and:

(a) if based on prior art, identify the prior art;

1 (b) if based on the first paragraph of 35 U.S.C.
2 § 112, (i) identify whether written description, enablement or best
3 mode will be the basis for the motion, and (ii) briefly identify the basis
4 for any alleged unpatentability:

5 (c) if based on an alleged failure to comply with
6 35 U.S.C. § 135(b), briefly identify the reason;

7 (d) if based on the second paragraph of 35
8 U.S.C. § 112, identify the limitation which is believed to be inde

9 (4) Proposed motion based on no interference-in-fact
10 shall briefly identify the reason no interference-in-fact is believed to
11 exist.

12 (5) Proposed motion to designate additional claims as
13 corresponding to a count or as not corresponding to a count shall
14 identify the claims involved.

15 (6) Proposed motion to add or substitute a new count
16 shall explain why the added or substitute count is necessary.

17 A motions list shall not contain any "reservation clause"
18 whereby a party purports to reserve a right to file additional motions.
19 Additional motions are those authorized by the Board consistent with
20 the rules.

21 A sample schedule for taking action during the motions phase
22 of the interference appears as Form 2 (page 69) of the STANDING
23 ORDER.

24 Counsel are encouraged to discuss the schedule prior to the
25 conference and agree to on times for taking action generally
26 consistent with the sample schedule.

27 A typical motions phase last about eight (8) months.

- 1 The parties should be prepared at the conference to justify any
- 2 request for shorter or longer time periods.
- 3

Part E

Identification of the Parties
Assignment of Exhibit Numbers
Initiating Settlement Discussions

Junior Party

Inventors: Anthony F. Hadfield, NY
Syed M. Shah, NJ
Michael W. Winkley, NY
Karen W. Sutherland, NY
James A. Provost, UK
Aeri Park, IN
Rex A. Shippelt, IN
Breton W. Russell, IN
Beat T. Weber, CH

Patent: U.S. Patent, 6,673,838 B2
granted 6 January 2004
based on application 10/073,743,
filed 11 February 2002

Title: Succinate salt of O-desmethyl-venlafaxine

Real party in interest: Wyeth

Senior Party

Inventors: Thomas P. Jerussi, MA
Chrisantha H. Senanayake, MA
Nandkumar N. Bhongle, MA

Application: Application 10/720,134,
filed 25 November 2003

Title: Derivatives of venlafaxine and methods of preparing and using the same

Real party in interest: Sepracor Inc.

Assignment of Exhibit Numbers

Senior party: Exhibit Numbers 1001 through 1999.

Junior party: Exhibit Numbers 2001-2999.

Board: Exhibit Numbers 3001-3999.

Initiating Settlement Discussions

STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

23 The senior party is responsible for initiating settlement
24 discussions required by the STANDING ORDER.

Part F Count and Claims of the Parties

4 The compound of claim 1 of Hadfield

or

6 The compound of claim 60 of Jerussi.

8 Hadfield claim 1 reads:

A compound which is O-desmethyl venlafaxine succinate.

10 Jerussi claims 60 reads:

11 A compound which is O-desmethylvenlafaxine succinate.

12

13 The claims of the parties are:

Hadfield: 1-46

17 Jerussi 60-71

19 The claims that correspond to Count 1 are:

Hadfield: 1-3 23-30 and 33-34

22

25 The claims that do not correspond to Count 1 are:

27 Hadfield: 4-22, 31-32, and 35-46

29 Jerussi: None

1 The parties are accorded an earlier constructive reduction to
2 practice (*i.e.*, benefit for the purpose of priority) of the following
3 applications:

4 Hadfield: None

5

6 Jerussi: Application 09/527,442,
7 filed 17 March 2000

Part G

Heading to be Used on Papers

The following heading shall be used on all papers filed in this interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper _____
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,685 McK
Technology Center 1600

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Patent 6,673,838 B2,
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v.

THOMAS P. JERUSSI, CHRISANTHA H. SENANAYAKE
and NANDKUMAR N. BHONGLE.

Application 10/720,134,
Senior Party.

Title of Paper, e.g., [Name of party] MOTION 1

Part H
Order Form for Requesting File Copies

3 When requesting file copies, a party shall use STANDING
4 ORDER Form 4 (page 71).

5 Use of form 4 will expedite processing of any request.

6 a party should attach to any request for file copies a photocopy
7 of Part E (for involved files) and Part F (for benefit files) of this
8 DECLARATION with a hand-drawn circle around the patent and
9 application files for which a copy of a file wrapper is requested.

10 The parties are advised that a single order for file copies may
11 be filled by the Office of Public Records at more than one time.
12 STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).

13

Part I

Required Paragraph of Affidavits and Declarations

4 The Board has experienced cases in which a witness has
5 belatedly advanced reasons why the witness would be unable to
6 appear for cross examination at a reasonable time and place in the
7 United States.

8 Consequently, to prevent surprise and hardship to the party
9 relying on the testimony of a witness, the following paragraph must
10 be included on the signature page of all affidavits (including
11 declarations) filed in this case. STANDING ORDER ¶ 157.2 (Paper
12 2, pages 52-53).

13 In signing this affidavit, I understand that the affidavit will
14 be filed as evidence in a contested case before the Board
15 of Patent Appeals and Interferences of the United States
16 Patent and Trademark Office. I also acknowledge that I
17 may be subject to cross examination in the case and that
18 cross examination will take place within the United States.
19 If cross examination is required of me, I will appear for
20 cross examination within the United States during the
21 time allotted for cross examination.
22

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3 (real party in interest Sepracor Inc.):
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24 (real party in interest Wyeth):
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